

ESTTA Tracking number: **ESTTA660808**

Filing date: **03/12/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91219893
Party	Defendant David O'Neill
Correspondence Address	ROBERT S BRODER ROBERT S BRODER PLLC 2903 PRESTON LN MERRICK, NY 11566-5216 UNITED STATES rsbroder@optonline.net
Submission	Other Motions/Papers
Filer's Name	Robert S. Broder
Filer's e-mail	rsbroder@optonline.net
Signature	/rsb/
Date	03/12/2015
Attachments	Motion to Set Aside2a.pdf(476247 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD

<hr/>		--X
INTERPOOL S.P.A.		Opposition No. 91219893
	Opposer	
	v.	MOTION TO SET ASIDE DEFAULT; DECLARATION OF DAVID O'NEILL, FILED CONCURRENTLY IN SUPPORT THEREOF; AND [PROPOSED] ANSWER
DAVID O'NEILL		
	Applicant.	
<hr/>		--X

I.

Introduction

Pursuant to Federal Rule of Civil Procedure ("FRCP") 55(c), and Trademark Trial And Appeal Board Manual Of Procedure ("TBMP") § 312.01 and § 312.02, Applicant, David O'Neill ("O'Neill"), hereby brings this Motion to Set Aside Default ("Motion") in the above referenced opposition and respectfully requests that the Notice of Default, dated February 11, 2015, be set aside for good cause.

II.

Statement of Facts

On November 18, 2014, Applicant's application for Mark "PRESTIGE 1687 DAVID JESUS" and Design" was published for opposition under Serial No. 86318256 (hereafter, the "Mark"). Opposer filed the instant Opposition on December 18, 2014. A Notice of Default issued on February 11, 2015.

Defendant's counsel informed Defendant on six different occasions via email about the opposition proceeding, however, due to his inability to access his email account until this week,

Applicant did not respond or give the undersigned counsel instructions until yesterday. Upon Applicant's instructions, the undersigned counsel immediately filed the instant Motion.

Applicant respectfully submits that his delay in filing his Answer was not willful or a result of gross neglect and was solely due to his inability to access his emails prior to this week and that the delay in filing his Answer, of less than 30 days, will not prejudice Opposer and that he that it has a meritorious defense that will succeed on the merits, namely that there is no likelihood of confusion between the parties' respective marks and that the Opposer has not made use of the mark in the United States. As Court's favor the litigation of cases on the merits, Applicant respectfully submits that the Notice of Default should be set aside.

III.

Legal Argument

The standard for whether or not a Notice of Default should be set aside is whether or not the movant shows "good cause." FRCP 55. The standard for good cause, as determined by the TTAB, is: (1) the delay in filing an answer was not the result of willful conduct or gross neglect on the part of the Applicant, (2) the Opposer will not be substantially prejudiced by the delay, and (3) the Applicant has a meritorious defense to the action. TBMP § 312.02.

There is no willful or gross neglect on the part of the defendant. Instead, there was a lack of communication between Defendant and his counsel, which led Defendant's counsel to believe that no action should be taken on the Opposition. [O'Neill Decl., ¶ 4 and 5].

Gross negligence is a high standard, and examples cited as such in the TBMP include failure to file an answer six months after the due date, far beyond the approximately 40 days since the due date in the instant action (February 1, 2015), which delay was inadvertent and not willful. In the instant case, the delay in filing Applicant's answer was due solely to Applicant not having access to his email and therefore the default should not be entered and Applicant's Answer should be accepted and the case proceed on the merits.

An examination of the factors demonstrates that Applicant is entitled to the relief it is seeking, namely setting aside the notice of default and litigating the case on the merits.

1. The Plaintiff Will Not Be Prejudiced

Here, there is no danger or prejudice the Plaintiff or Opposer in granting the present Motion. Opposer would not be prejudiced by a delay of a little more than one month by granting the present Motion, resetting the schedule, and entering Applicant's answer.

2. The Default Was Not Willful

In the accompanying declaration, Applicant represents that, notwithstanding the undersigned counsel's emails alerting him of the opposition, answer and default deadlines he did not have access to his emails and therefore did not receive notice until this week. Upon receipt of notice Applicant immediately contacted the undersigned and instructed me to file the instant motion. Applicant's failure to timely file his Answer was not willful or gross negligence.

3. Applicant Has Meritorious Defense on the Merits to the Opposition

Generally, the submission of an answer is considered satisfactory for satisfying there is a meritorious defense. *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (the two other factors having been shown, Defendant was allowed time to show meritorious defense by submission of answer). Furthermore, "the showing of a meritorious defense does not require an evaluation of the merits of the case. All that is required is a plausible response to the allegations in the complaint." *DeLorme*, supra at 1224. Pursuant to TBMP § 312.01, Applicant hereby submits its Answer concurrently with the instant Motion.

It is well settled that notices of default and judgments are generally disfavored and cases should be decided upon their merits where a movant, as is the case here, seeks timely relief from the default judgment and has a meritorious defense, doubts should be resolved in favor of granting the motion to set aside the judgment. FRCP 55 is to be liberally construed in order to provide relief from onerous consequences of defaults and default judgments, to provide relief from the onerous consequences of such an entry, and with any doubt being resolved in favor of setting aside. *Tolson v. Hodge*, (N.C. 1969) 411 F.2d 123; *Barber v. Turberville*, 218 F.2d 34; *Horn v. Intelectron Corp.*, (S.D.N.Y.1968), 294 F.Supp. 1153; *Singer Co. v. Greever and Walsh Wholesale Textile, Inc.*, (E.D.Tenn.1977), 82 F.R.D. 1; *Johnson v. Harper*, (D.C.Tenn.1975), 66 F.R.D. 103; *Hamilton v. Edell*, (E.D.Pa.1975), 67 F.R.D. 18.

TBMP § 312.01 likewise states:

In exercising that discretion, the Board must be mindful of the fact that it is the policy of the law to decide cases on their merits. Accordingly, the Board is very reluctant to enter a default judgment for failure to file a timely answer, and tends to resolve any doubt on the matter in favor of the defendant.

Accordingly, the Board should liberally construe the statute in this instant matter and grant the instant Motion and accept Applicant's Answer and reset the conference, discovery, disclosure and trial schedules, so that the opposition may be litigated on its merits as is preferred under the law.


IV.

Conclusion

For the foregoing reasons, the Motion should be granted, the default set aside, and Applicant's proposed Answer accepted.

Dated: March 12, 2015

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "R. Broder", written over a horizontal line.

Robert S. Broder

ROBERT S. BRODER, PLLC
2209 Merrick Road – Suite 2014
Merrick, NY 11566
T: 516.771.0349
Email: rsbroder@optonline.net.
ATTORNEY FOR APPLICANT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD

INTERPOOL S.P.A.

Opposition No. 91219893

Opposer

DECLARATION OF
DAVID O'NEILL IN SUPPORT OF
MOTION TO SET ASIDE NOTICE OF
DEFAULT

v.

DAVID O'NEILL

Applicant.

DECLARATION OF DAVID O'NEILL

I, David O'Neill, does hereby declare:

1. I am over the age of eighteen and I have personal knowledge of the following facts and I submit this Declaration in support of Applicant's Motion to Set Aside Default ("Motion").
2. I am the Applicant ("Applicant") in the instant Opposition proceeding.
3. I was contacted by email numerous times by my attorney, Robert S. Broder, with respect to the deadline to file an Answer in the instant opposition proceeding.
4. Due to my inability to access my email account prior to the deadline, I was not aware of the deadline to file the answer or the notice of default prior to this week. Once I learned of the notice of default, I immediately contacted my attorney and instructed him to file the instant motion and answer.
5. My inability to access my email was not willful or grossly negligent.

6. I hereby declare and state that under penalty of perjury all statements made herein of my knowledge are true, and all statements made on information and belief are believed to be true and further these statements made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the defense to the captioned Opposition.

Dated: March 11, 2015



David O'Neill

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

----- X		
INTERPOOL, S.P.A.	Opposer,	: Opposition. No. <u>91219893</u>
		:
	vs.	: ANSWER TO NOTICE OF
		: OPPOSITION
		:
DAVID O'NEILL	Applicant,	:
		:
		:
		:
		:
----- X		

Applicant, David O'Neill, ("Applicant"), by its undersigned attorneys, for its Answer to the Notice of Opposition (the "Notice") filed by Opposer, Interpool, S.P.A. ("Opposer"), respectfully alleges as follows:

1. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 1 of the Notice.
2. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 2 of the Notice
3. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 3 of the Notice.
4. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 4 of the Notice.
5. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 5 of the Notice.
6. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 6 of the Notice.

7. Applicant admits the allegations set forth in paragraph 7 of the Notice.
8. Applicant realleges its answers in paragraphs 1-8 and incorporates paragraphs 1-8 as if fully set forth herein.
9. Applicant denies the allegations set forth in paragraph 9 of the Notice.
10. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 10 of the Notice.
11. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 11 of the Notice.
12. Applicant denies the allegations set forth in paragraph 12 of the Notice.
13. Applicant denies the allegations set forth in paragraph 13 of the Notice.

FIRST AFFIRMATIVE DEFENSE

14. Opposer has not used its mark in the United States

SECOND AFFIRMATIVE DEFENSE

15. The Notice fails to state a claim upon which relief can be granted. Opposer cannot establish the requisite elements of proving any likelihood of confusion under the factors set forth in In re E.I. DuPont DeNemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973). Indeed, the marks are visibly distinctive and create entirely different commercial impressions.

THIRD AFFIRMATIVE DEFENSE

16. Opposer's mark is highly diluted and weak due to numerous co-existing registered marks and applications, all of which feature buildings with columns, in International Class 25 for apparel and Opposer's mark is therefore entitled to limited and narrow protection.

WHEREFORE, Applicant respectfully requests that the Board:

- (a) Dismiss the Opposition with prejudice on the merits;
- (b) Allow application Serial No: 86318256 to issue for the mark PRESTIGE 1687 DAVID JESUS [and Design]; and

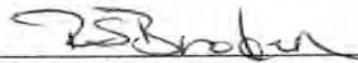
(c) Grant Applicant such other and further relief as the Board deems just and proper.

Dated: Merrick, New York

March 12, 2015

Respectfully submitted,

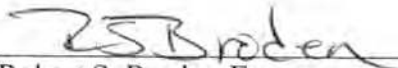
ROBERT S. BRODER, PLLC

By 
Robert S. Broder, Esq.
2209 Merrick Road - Suite 204
Merrick, NY 11566
Phone: 516.771.0349
Attorney for Applicant, David O'Neill

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on March 12, 2015, on behalf of Applicant, he served the foregoing MOTION TO SET ASIDE NOTICE OF DEFAULT; DECLARATION OF DAVID O'NEILL, FILED CONCURRENTLY IN SUPPORT THEREOF; and [PROPOSED] ANSWER on the Opposer by depositing a true copy of same in a sealed envelope, postage prepaid, by First-Class, U.S. mail, addressed to Opposer's counsel as follows:

Laura T. Geyer, Esq.
Vorys Sater Seymour & Pease LLP
1909 K Street NW, Ninth Floor
Washington, DC 20006


Robert S. Broder, Esq.
Counsel for Applicant